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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/664,494

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Guy Nathan

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7590

05/18/2004

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1100 North Glebe Road 8th Floor  
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EXAMINER

BUI, KIEU OANH T

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/664,494

Applicant(s)

NATHAN, GUY

Examiner

KIEU-OANH T BUI

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5-7</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because all figures with boxes should be labeled with text descriptions. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Abstract***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Abstract should be revised and corrected as required.

### ***Claim Objections***

3. Claims 3, 5, 6, 7, 8, 11, and 17 are objected to because of the following informalities: the format of dependency, i.e., claim X depends on a multiple of claims or either to claim Y or to claim Z, is not appropriate in the U.S. patent practices. Appropriate correction is required.

***Claim Rejections - 35 USC 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3, 5-6, 8-11, 13-14, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Tran et al. (U.S. Patent No. 6,157,935/ or "Tran" hereinafter).

Regarding claim 1, Tran discloses "a method of distributing audio-visual information between a server and at least one terminal connected by means of bi-directional communication to the server (Figs. 1 & 5, and col. 21/lines 3-22 for a client/server system with bi-directional communication link) characterized in that the method comprises:

a registration step for each terminal at the server in order to identify the terminal in a unique fashion and to register the type of terminal, i.e., registration is performed by authentication process based on IP standard for a variety of terminals (col. 8/lines 5-20);

a step of authentication of the terminal by the server on every connection of the terminal to the server, i.e., for each connection based on each terminal device, authentication process is done (col. 8/lines 5-38);

a step of downloading at least one selection of audio-visual information chosen by the user of the terminal during its connection to the server, the format in which the selections of audio-visual information are transmitted being such that only the destination terminal is able to make use of it, i.e., a format such as file transfer protocol with built-in security feature is provided to each terminal as the terminal requests and downloads files comprising audio-visual information (col. 30/lines 20-55; and Fig. 1, and col. 2/line 52 to col. 3/line 39 for audio-visual information);

a step of storing the use made of each selection of audio-visual information in a data base of the server, i.e., the user can store the audio-visual information in the earlier step in a database for further analysis (col. 2/line 52 to col. 3/line 17).

As for claims 2, 11, and 13, in further view of claim 1, Tran further discloses “the use of a selection of audio-visual information comprises, either the running in real time of the audio-visual information on the destination terminal, or the storing of the audiovisual information for the purpose of running it on the destination terminal, or the running, in real time, of the audio-visual information, after storing the audiovisual information on the destination terminal”, i.e., audio-visual information can be storing to the server and to the terminal, either in real-time or at later use for a larger display (col. 3/line 5-40).

As for claim 3, in further view of claim 1 (assuming to 1), Tran further discloses “the authentication step includes a step of the terminal sending stored information relating to the desired uses to be made of the audio-visual information downloaded onto the terminal”, i.e., a user specific data is stored in a database (col. 5/lines 30-55), and preference or relevant information to the user is learned or collected by the “smart agent” (software entity) and then the

agent provides the appropriate audio-visual information based on that collection (Fig. 22, and col. 34/line 42 to col. 35/line 10).

As for claim 5, in further view of claim 1 (assuming), Tran further teaches “the registration step comprises a step of sending decoding and/or decryption means as a function of the format in which the audio-visual information will be transmitted to the terminal and which corresponds to the specified uses”, i.e., a Java interpreter or appropriate protocol converter is used for decoding into a format suitable to view for the user (col. 30/lines 7-56; and col. 8/lines 5-50 for encryption included, meaning decryption is included at the terminal for the conversion).

As for claim 6, in further view of claim 1 (assuming), Tran further discloses “the type of terminal defines the use which will be made of the audio-visual information on the terminal” (col. 7/line 25 to col. 8/line 59 for a variety of terminal and its corresponding uses according to its type whether a camera, a cell phone, a pager, a computer terminal and so on).

As for claim 8, in further view of claim 1 (assuming), Tran further suggests comprising “a step of storing on the terminal, statistical records concerning the use of the selections stored by the terminal and a step of sending, by the terminal, of information corresponding to the statistical records, during connection between the terminal and the server (Figs. 22, 23 & 25 for the process; and claim 2 for the storing on the terminal addressed).

Regarding claim 9, Tran teaches “a device for the distribution of audio-visual information comprising a server including mass data storage means that include audio-visual information for representing a plurality of musical and/or video selections, and at least one terminal including data storage means and a bi-directional communication link with the server, the device being characterized in that the data storage means of the server comprise an identification of each

terminal defining the use of the audio-visual information transmitted to the terminal, each terminal comprising means interactive with the user to permit the choice of at least one selection through the communication link with the server and means of running the information sent by the server and representative of an audio-visual selection”, i.e., musical and/or video selections for downloading to the terminal (see Fig. 1, and col. 5/lines 3-55) and either a fixed address or a globally unique virtual IP address assigned to each mobile terminal for identification purpose (col. 22/line 33 to col. 23/line 20; and the rest of limitations are already addressed in earlier claims).

As for claim 10, in view of claim 9, Tran discloses “each terminal is connected, through a bi-directional link, to a multi-service server also connected to the server through a bi-directional link, each multi-service server comprising means for transmitting, on the one hand, each message from the server intended for the terminal and, on the other hand, each message from the terminal intended for the server” (Fig. 5, and col. 20/line 30 to col. 21/line 22).

As for claim 14, Tran discloses “a device for the distribution of audio-visual information according to Claim 11, characterized in that the terminal comprises means of recording information relating to the use made of the selections sent by the server to the terminal” (user profile or relevant information or user specific data in earlier claims 2-3).

As for claim 16, Tran discloses a device for the distribution of audio-visual information according to claim 11 comprising “the exploitation means comprise a Digital Signal Processor DSP comprising means of decoding audio-visual information transmitted by the server in order to provide digital information, a digital-analog converter, to at least one output for digital information to data storage means and command means for each digital output in order to

authorize or not to authorize the storage of the digital information” (col. 5/line 30 to col. 6/line 15).

As for claim 17, in view of claims 9, Tran further discloses “means interactive comprising selection means including a pointer and or a touch screen associated with displays means for displaying at least one dialogue screen, and/or a vocal command system associated with audio reproduction means for restituting at least one vocal message” (Fig. 1, col. 5/lines 3-15 & col. 10/line 46 to col. 11/line 39 for user interface as pen on a touch screen of the display; and a vocal command as the user speaks to give their commands, see col. 13/line 40 to col. 14/line 23 & col. 15/line 45 to col. 16/line 18).

### ***Claim Rejections - 35 USC 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

7. Claims 4, 7, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tran et al. (U.S. Patent No. 6,157,935).

Regarding claims 4 and 15, in further view of claims 3 and 14, Tran does not mention “comprises a step in which the server processes information stored or received and relating to the uses for the audio-visual information downloaded onto the terminal in order to determine the amount of royalties to be paid to each of the parties having rights over the audio-visual



information”; however, the Examiner takes Official notice that this is well-known in the art since the service provider can charge the user a fee for any service that the provider provides to the user based on their requests. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tran’s system with a known feature as noted in order to charge the user an amount of royalties in exchange for the user’s rights to download the audio-visual information from the service provider.

As for claim 7, in further view of claim 1 (assuming), the limitation of “step of paying for the selections commanded, either during the authentication step or during the choice of the user, or before the downloading step” is rejected for the reason given in the scope of claim 4 as noted above, whether the provider decides to grant the access to the user by collecting the fee during the authentication step or during the choice of the user or before downloading step.

As for claim 12, in view of claim 11, Tran does not mention “the running means of the terminal comprise means of forbidding the re-use of the audiovisual information sent”; however, this technique is well-known in the art because, in view of claim 4 above, the service provider controls the granting of downloading and access of the user to the services such that only one time download is granted and more than one or the re-use of the audiovisual information can be prohibited. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tran’s system with a known feature as noted in order to prohibit the multiple accesses or re-use of the user to the audiovisual information service.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mattaway et al. (US Pat. No.6,131,121) disclose a point-to-point computer network communication utility utilizing dynamically assigned network protocol addresses.

Tran (U.S. Pat. No. 6,202,060 B1) discloses a data management system.

Mattaway et al. (U.S. Pat. No.6,185,184 B1) disclose a directory server for providing dynamically assigned network protocol addresses.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9306, (for Technology Center 2600 only)**


*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui  
Art Unit 2611  
May 7, 2004



KRISTA BUI  
PATENT EXAMINER